

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ANDREW PERKINS

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Appeal 2007-2743  
Application 10/766,754  
Technology Center 3700

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Decided: October 12, 2007

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Before WILLIAM F. PATE, III, TERRY J. OWENS, and JOSEPH A. FISCHETTI, Administrative *Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant appeals from a rejection of claims 1-20, which are all of the pending claims.

THE INVENTION

The Appellant claims an apparatus and method for making a string of air-filled packing cushions. Claim 1 is illustrative:

1. Apparatus for making a packing material in the form of a string of air-filled packing cushions with rows of perforations extending across the material between the cushions, comprising:

means for feeding superposed layers of film material having longitudinally spaced, transversely extending rows of perforations along a path, means for injecting air between the two layers of film material, means for sealing the layers of film material together to form air-filled cushions between the rows of perforations, and means engagable with the string of air-filled cushions for partially tearing the material along the rows of perforations to facilitate tearing a desired number of the air-filled cushions from the string.

#### THE REFERENCES

Bolton	US 4,493,684	Jan. 15, 1985
Meschi	US 5,230,453	Jul. 27, 1993
Fuss	US 6,582,800 B2	Jun. 24, 2003

#### THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1, 3, 5-7, 9, 11, 13-15, 17, 19 and 20 over Fuss in view of Bolton, and claims 2, 4, 8, 10, 12, 16 and 18 over Fuss in view of Bolton and Meschi.

#### OPINION

We reverse the rejections as to all claims except claim 6. We need to address only the independent claims, i.e., claims 1, 6, 9, 14, 15 and 20, and dependent claim 7.<sup>1</sup>

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<sup>1</sup> The Examiner does not rely upon Meschi for any disclosure that remedies the deficiency in Fuss and Bolton as to independent claims 1, 9, 14, 15 and 20.

Claims 1, 7, 9, 14, 15 and 20

Claims 1, 7, 9, 14, 15 and 20 require partially tearing rows of perforation after air-filled cushions have been formed between the rows of perforation. Claim 1 recites “means engagable with the string of air-filled cushions for partially tearing the material along the rows of perforations”. Claim 7, which depends from independent claim 6, recites that “the material is torn by continuously engaging an edge portion of the material with a feed roller after the air-filled cushions are formed”. Claims 9 and 14 recite “partial tearing along the rows of perforations between the inflated chambers”. Claims 15 and 20 recite “air-filled packing cushions” and “partial tearing along the rows of perforations between the cushions”.

Fuss discloses a string of air-filled plastic film cushions separated by perforations (19) for tearing the cushions apart (col. 1, l. 49 – col. 2, l. 2; col. 2, ll. 49-53; fig. 6).

Bolton discloses

a method for making a supply of partially separated multibag units, comprising first passing a perforated chain of side-sealed bags through a first set of driven nip rollers, then passing said chain directly to a second set of nip rollers having a partial nip of selected width less than the width of said chain, while driving said second nip rollers at a speed greater than said first nip rollers sufficient to partially separate the bags at their representative lines of perforation, and while cyclically completing the nip of said second nip rollers at predetermined intervals corresponding to the number of bags desired in each multibag unit. [col. 2, ll. 26-37]

\* \* \*

Downward pressure is exerted as indicated at arrow **59A** on partial separator mechanism **59** having pivot arm **62** supporting partial separator rollers **63A**, **B**, etc. Pressure at **59A** is normally held

essentially constant to effect partial separation along the lines of perforation within the series of bags, as previously shown in Fig. 2A by segment AB for example. [col. 4, ll. 13-20]

The Examiner argues that Bolton partially tears the lines of perforation at their edge portions (Ans. 4).<sup>2</sup> The Examiner is incorrect. Bolton's torn portion is in the central portion of each line of perforation, i.e., the portion AB in Fig. 2A.

The Examiner argues that "one skill[ed] in the art when applying the teaching, as taught by Bolton, would apply the tearing rollers where the partial tearing is needed, in this case, at the edge of the string of perforated bags" (Ans. 8). The Examiner, however, has not provided evidence of a need for tearing a line of perforation at its edge portion. The record indicates that for that claim feature the Examiner relies only upon the Appellant's disclosure and, therefore, used impermissible hindsight. *See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

We therefore reverse the rejections as to claims 1-5 and 7-20.

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<sup>2</sup> The Appellant's tear rollers (56, 57) partially tear the lines of perforation at their edge portions because the central portions are occupied by air-filled cushions (see Appellant's fig. 1, where item 51 is the partial tearing mechanism).

### Claim 6

Claim 6 is a method claim that does not require performing the steps in the recited order. Claim 6 requires “partially tearing the material along the rows of perforations to facilitate tearing a desired number of the air-filled cushions from the spring.” The claim encompasses partially tearing the material along the rows of perforations and then forming the air-filled cushions, provided that the partial tearing facilitates tearing of the subsequently formed air-filled cushions.

Bolton’s disclosure that partially tearing lines of perforation between bags eases the separation of the bags (col. 3, ll. 57-61) would have led one of ordinary skill in the art, through no more than ordinary creativity, to use Bolton’s technique to partially tear the lines of perforation in Fuss’s plastic film, before the air-filled cushions are formed, to facilitate tearing of the subsequently formed air-filled cushions. *See KSR Int’l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (In making an obviousness determination one “can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”).

The Appellant does not provide a substantive argument as to the separate patentability of claim 6 but, rather, merely argues that the recited “combination is neither found in nor suggested by the references” (Br. 6).

For the above reasons we affirm the rejection of claim 6.

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DECISION

The rejection of claims 1, 3, 5-7, 9, 11, 13-15, 17, 19 and 20 over Fuss in view of Bolton under 35 U.S.C. § 103 is reversed as to claims 1, 3, 5, 7, 9, 11, 13-15, 17, 19 and 20, and affirmed as to claim 6. The rejection of claims 2, 4, 8, 10, 12, 16 and 18 under 35 U.S.C. § 103 over Fuss in view of Bolton and Meschi is reversed.

AFFIRMED-IN-PART

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